

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**Attorney Docket No.: 14543US02**

In the Application of:

Jeyhan Karaoguz, *et al.*

Serial No.: 10/675,410

Filed: September 30, 2003

For: PERSONAL STREAMING AND
BROADCAST CHANNELS IN A
MEDIA EXCHANGE NETWORK

Examiner: Ryan, Patrick A.

Filed electronically on January 20, 2011

Group Art Unit: 2427

Confirmation No.: 6495

PRE-APPEAL BRIEF REQUEST FOR REVIEWMail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Paper responds to the Final Office Action mailed October 13, 2010. The Applicants request a 1-month extension of time in which to respond. Thus, the period for response runs until February 13, 2011.

The Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

Date: January 20, 2011By: /Joseph M. Butscher/
Joseph M. Butscher
Reg. No. 48,326McANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000

REMARKS

The present application includes pending claims 1-33, all of which remain rejected. In particular, claims 1-33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 2002/0016971 ("Berezowski") in view of U.S. 6,774,926 ("Ellis"), U.S. 2004/0125789 ("Parker") and U.S. 7,321,969 ("Schoen"). As explained below, however, the Office Action fails to establish a *prima facie* case of obviousness with respect to the pending claims for a variety of reasons.

The Applicants note that "[i]f the examiner is able to render a claim obvious simply by saying it is so, neither the Board nor [the Federal Circuit] is capable of reviewing that determination. ... If there is neither record evidence nor detailed examiner reasoning, the Board should not conclude that ... claims are obvious." *See In re Vaidyanathan*, Appeal 2009-1404 at pages 18-19 (Fed. Cir. May 19, 2010) (nonprecedential).

"[W]hile *KSR* relaxed some of the formalism of earlier decisions requiring a 'teaching, suggestion, or motivation' to combine prior art references, it did not remove the need to anchor the analysis in explanation of how a person of ordinary skill would select and apply the teachings of the references." *See id.* at page 17. Moreover,

KSR did not free the PTO's examination process from explaining its reasoning. In making an obviousness rejection, the examiner **should not rely on conclusory statements** that a particular feature of the invention would have been obvious or is well known. Instead, the examiner should elaborate, discussing the evidence or reasoning that leads the examiner to such a conclusion. Generally, the examiner cites prior art references to demonstrate the state of knowledge.

Id. (emphasis added).

"[T]he Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

With those principles in mind, claim 1 recites, in part, "second software resident in a first memory at the first home configured to enable a user at the first home to

construct, at the first home, the at least one user defined media channel, the second software also configured to enable closed and secure communication of the at least one user defined media channel to other members within the user defined group of users that are at separate and distinct locations from the first home, in a peer-to-peer manner, from the first home.” Independent claims 13, 20, and 26 recite similar limitations. The Office Action fails to establish that the proposed combination of references describes, teaches, or suggests all of these limitations. *See* August 2, 2010 Response at pages 15-26.

The Applicants explain in detail that the Office Action’s reliance on cited portions of the cited references is in clear error. *See id.*

The Office Action acknowledges that Berezowski does not describe, teach, or suggest certain aspects of the claims. *See* October 13, 2010 Office Action at pages 9-10. In an attempt to overcome these acknowledged deficiencies, the Office Action relies on Ellis. *See id.* at page 10.

The Applicants respectfully note that the Office Action merely describes what Ellis purportedly teaches and does not explicitly identify teachings of Ellis as corresponding to **specific elements** of claim 1. *See id.* Indeed, no reference to the language of claim 1 is made. *See id.* Instead, the Office simply provides a high-level description of what Ellis allegedly teaches, in isolation from the actual limitations of claim 1, and therefore does not demonstrate specifically what portion of Ellis allegedly teaches each of the elements admittedly missing from Berezowski. Because the Office Action fails to make the rejection explicit, as required by Federal Circuit case law and the MPEP, the Office Action fails to establish a *prima facie* case of unpatentability.

Nevertheless, the Office Action cites Ellis at col. 11, line 65 to col. 12, line 3; col. 4, lines 59-67; col. 12, lines 8-53; col. 13, line 29 to col. 14, line 32; and col. 7, lines 27-37 as teaching aspects of claim 1 admittedly missing from Berezowski. *See id.* The Applicants respectfully note, however, that the Office Action does not show where any other art provides support for a rejection of those aspects of claim 1 admittedly missing from Berezowski.

The Applicants demonstrate, in detail, that the portions of Ellis that the Office Action relies upon do not describe, teach, or suggest the limitations of claim 1 noted above. See August 2, 2010 Response at pages 17- 26. In particular, the Office Action fails to show where any of the cited references expressly or necessarily describes, teaches, or suggests **“communication of the at least one user defined media channel to other members** that are at separate and distinct locations from the first home, **in a peer-to-peer manner, from the first home,”** as recited in claim 1, for example.. The Applicants respectfully submit that because Ellis does not teach what was asserted by the Office Action, Ellis also does not describe, teach, or suggest “the second software also configured to enable closed and secure communication of the at least one user defined media channel to other members within the user defined group of users that are at separate and distinct locations from the first home, in a peer-to-peer manner, from the first home,” as recited in claim 1, for example. Further, the Applicants respectfully note that the Office Action does not assert that any other art, including the remaining cited art, describes, teaches, or suggests at least this aspect of claim 1, for example. For at least these reasons, the Office Action has failed to establish a *prima facie* case of unpatentability with respect to claim 1, for example, and the claims depending therefrom.

Additionally, claim 1 recites, in part, “first software that maintains a user defined group of users comprising the first and second users, wherein the user defined group of users is closed and secure with respect to others that are not members of the user defined group of users, wherein a member within the user defined group of users can privately share media content comprising audio and/or video with one or more other members within the user defined group of users.” Claims 13, 20, and 26 recite similar features. The Office Action also fails to establish that the cited references describe, teach, or suggest all of these limitations. See August 2, 2010 Response at pages 26-29. Thus, for at least these reasons, the Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of unpatentability with respect to the pending claims. See *id.* at pages 29.

Moreover, "It is important for Office personnel to recognize that when they do choose to formulate an obviousness rejection using one of the rationales suggested by the Supreme Court in KSR and discussed in the 2007 KSR Guidelines, they are to adhere to the instructions provided in the MPEP regarding the necessary factual findings." See September 1, 2010 Examination Guidelines Update (emphasis added).

It is "Office policy that appropriate factual findings are required in order to apply the enumerated rationales properly. If a rejection has been made that omits one of the required factual findings, and in response to the rejection a practitioner or inventor points out the omission, Office personnel must either withdraw the rejection, or repeat the rejection including all the required factual findings." See *id.* (emphasis added).

The Examination Guidelines Update also states the following:

Simply stating the principle ... without providing an explanation of its applicability to the facts of the case at hand is generally not sufficient to establish a *prima facie* case of obviousness.

The Applicants respectfully request reconsideration of the claim rejections for at least the reasons discussed above.

The Applicants previously paid \$510 for the Notice of Appeal on June 26, 2008. Therefore, the Applicants owe \$30 for the current Notice of Appeal. The Commissioner is authorized to charge any necessary fees, including the \$130 fee for the 1-month extension and the \$30 fee for the Notice of Appeal, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

Date: January 20, 2011

/Joseph M. Butscher/
Joseph M. Butscher
Registration No. 48,326

McANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
Telephone: (312) 775-8000
Facsimile: (312) 775-8100